

**REMARKS**

In the final Office Action, claims 1-8, 10-23, 26-28, and 31-37 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,571,003 ("*Hillebrand*") and U.S. Patent No. 6,208,749 ("*Krusin*"); claims 24 and 29 were rejected under 35 U.S.C. § 103(a) based on *Hillebrand*, *Krusin*, and U.S. Patent No. 3,030,967 ("*Peyron*"); and claims 25 and 30 were rejected under 35 U.S.C. § 103(a) based on *Hillebrand*, *Krusin*, and "Ultraviolet Radiation," EHC Journal, 1994 ("*EHC Journal*"). Applicants respectfully request reconsideration and withdrawal of the rejections for the following reasons.

**A. Rejection of Claims 1-8, 10-23, 26-28, and 31-37 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 1-8, 10-23, 26-28, and 31-37 based on *Hillebrand* and *Krusin* because the final Office Action has failed to set forth a *prima facie* case of obviousness. No *prima facie* case of obviousness has been established with respect to claims 1-8, 10-23, 26-28, and 31-37 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

The M.P.E.P. advises that "[t]o establish a *prima facie* case of obviousness, . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," and, among other criteria, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." § 2143. According to the M.P.E.P., "[t]he teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, not in applicant's

disclosure." *Id.* (citation omitted). Furthermore, the M.P.E.P. cautions that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." § 2143.01 (citation omitted) (emphasis in original).

For example, independent claim 1 recites a method comprising, among other things, "displaying [a] skin condition image such that [a] subject is substantially unidentifiable." *Hillebrand* and *Krusin* fail to teach or suggest at least this element of claim 1.

On page 4 of the final Office Action, the Examiner alleged that "if an image of just a skin (or sub-image) of the subject is taken and displayed as disclosed by *Hillebrand*, the subject would be unquestionably unidentifiable" (underline added). However, Applicants respectfully submit that, contrary to the Examiner's allegations, *Hillebrand* does not disclose displaying a skin condition image of the subject such that the subject is substantially unidentifiable. Instead, *Hillebrand* merely discloses identifying defects on a subject's facial image and displaying the defects on the facial image (Figs. 11-14; col. 5, lines 27-28; col. 11, lines 4-13). Applicants' representative has reviewed the disclosure of *Hillebrand*, and nowhere does *Hillebrand* disclose displaying an image of skin of the subject such that the subject is "unquestionably unidentifiable," as alleged by the Examiner. Indeed, *Hillebrand* discloses displaying the defects on a digital image of the subject's identifiable face (Fig. 5; col. 5, lines 27-28), which is the exact opposite of displaying a skin condition image of the subject such that the subject is substantially unidentifiable, as recited in claim 1.

Further, the Examiner acknowledged on page 4 of the final Office Action that *Hillebrand* “does not explicitly teach directly taking an image of the subject’s skin.”<sup>1</sup> Despite that acknowledgement, the Examiner, in the discussion of claim 1 on page 4 of the final Office Action, modified the disclosure of *Hillebrand* to include “directly taking an image of the subject’s skin.” Specifically, the Examiner alleges *Krusin* discloses “directly taking an image of the subject’s skin” and that it would have been obvious to modify *Hillebrand* to include this because it will “keep the secrecy of the subject.” This conclusion, however, is not properly supported by evidence in the prior art.

The M.P.E.P. makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (citations omitted). The Examiner has not shown that the cited art “suggests the desirability” of the alleged modification to “keep the secrecy of the subject.” Neither *Hillebrand* nor *Krusin* mentions anything about keeping the secrecy of the subject. Indeed, as discussed above, *Hillebrand* expressly discloses displaying the defects on a digital image where the subject’s face is identifiable, which teaches away from keeping the secrecy of the subject. Accordingly, the conclusions in the Office Action were not reached based on facts from the prior art, but instead the teachings of the present application were improperly used in hindsight to reconstruct the prior art.

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<sup>1</sup> Applicants note that claim 1 does not contain any recitation of “directly taking an image of the subject’s skin.”

As to claims 34-37, the rejection under 35 U.S.C. § 103(a) based on *Hillebrand* and *Krusin* should be withdrawn because the Office Action fails to set forth a *prima facie* case of obviousness. On page 10 of the Office Action, the Examiner alleged that *Hillebrand* discloses the analysis of hair or nails. Specifically, the Examiner attempts to equate analysis of spots on skin with analysis of hair or nails. See Office Action, page 10. However, the analysis of spots on skin is not the same as, and does not suggest, analysis of hair or nails, and there is no suggestion in the cited art indicating otherwise. For example, as described in *Hillebrand*, analysis of spots is the analysis of inflamed red spots such as acne, or hyperpigmented spots such as senile lentigines (i.e., small flat pigmented spots), nevi (i.e., moles), and freckles (col. 8, lines 6-10). This is not the same as, and does not suggest, analysis of hair or nails.

Independent claims 22, 27, 32, and 33, although of different scope, recite elements similar to those of claim 1 discussed above. Independent claim 22, for example, recites a method comprising, among other things, extracting at least one representation of at least one skin condition from at least one image of at least one portion of a subject's facial skin, "wherein the extracting occurs to an extent that the subject is anonymous when the representation is viewed," and "displaying the representation such that the subject is anonymous." Independent claim 27 recites a method comprising, among other things, "displaying [a] skin condition image such that [a] subject is substantially unidentifiable." Independent claim 32 recites a system comprising, among other things, a "processor configured to identify in [an] image at least one skin condition and for extracting from the image at least one representation of

the at least one skin condition to thereby protect the subject's identity." Independent claim 33 recites a method comprising, among other things, "providing software for modifying . . . at least one image to remove at least some . . . information unrelated to . . . skin analysis, thereby protecting the subject's identity during transmission."

Accordingly, for at least the above reasons, the rejection of independent claims 1, 22, 27, 32, 33, 34, and 36 under 35 U.S.C. § 103(a) should be withdrawn. Moreover, the Section 103(a) rejections of dependent claims 2-8, 10-21, 23, 26, 28, 31, 35, and 37 should also be withdrawn at least by virtue of the dependence of those claims upon one of allowable claims 1, 27, 34, and 36.

**B. Rejection of Claims 24 and 29 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 24 and 29 based on *Hillebrand*, *Krusin*, and *Peyron* because the final Office Action has failed to set forth a *prima facie* case of obviousness. No *prima facie* case of obviousness has been established with respect to claims 24 and 29 for at least the reason that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in the manner proposed by the Examiner.

Independent claim 24 recites a method of performing a skin analysis comprising various elements, "wherein skin in [a] received image is covered with powder to facilitate extracting . . . at least one representation." Claim 29, although of different scope, includes a similar recitation.

On page 11 of the Office Action, the Examiner properly observed that *Hillebrand* and *Krusin* fail to teach or suggest this element. The Examiner sought to cure the deficiency of *Hillebrand* and *Krusin* by relying on *Peyron*, which discloses using powder on skin to emphasize skin defects. See Office Action, page 11 (citing *Peyron*, col. 1, lines 37-42). The Examiner alleged that it would have been obvious to modify the combination of *Hillebrand* and *Krusin* with *Peyron* because it “would help in obtaining better image skin analysis results.” *Id.* However, *Peyron* makes no mention of image skin analysis. Instead, *Peyron* discloses a process to more evenly apply cosmetic material to the skin to hide defects (col. 1, lines 55-64). In fact, *Peyron* discloses that accentuating skin defects with make-up products was a problem and not something to be desired (col. 1, lines 29-37). Hence, the Examiner has not shown that the prior art suggests the desirability of using powder to facilitate extracting a representation from a skin image to “help in obtaining better image skin analysis results.” Office Action, page 11. Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness, and is instead using the teachings of the present application in hindsight to reconstruct the prior art.

Accordingly, for at least the above reasons, the rejection of independent claims 24 and 29 under 35 U.S.C. § 103(a) should be withdrawn.

**C. Rejection of Claims 25 and 30 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection of claims 25 and 30 based on *Hillebrand*, *Krusin*, and *EHC Journal* because the final Office Action has failed to set forth a *prima facie* case of obviousness. No *prima facie* case of

obviousness has been established with respect to claims 25 and 30 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

Independent claim 25 recites a method of performing a skin analysis comprising, among other things, "extracting from . . . at least one [received] image at least one representation of . . . at least one skin condition . . ., wherein skin in the received image is illuminated with a Woods lamp to facilitate extracting the at least one representation." Claim 30, although of different scope, includes a similar recitation.

On pages 11 and 12 of the Office Action, the Examiner properly observed that *Hillebrand* and *Krusin* fail to teach or suggest this element. The Examiner sought to cure the deficiency of *Hillebrand* and *Krusin* by relying on *EHC Journal*. According to the Examiner, *EHC Journal* teaches using a Woods lamp in skin analysis. See Office Action, page 12 (citing *EHC Journal*, page 45). However, *EHC Journal* makes no mention of, and does not suggest, using a Woods lamp to facilitate extracting of a representation of a skin condition from a received image, as recited in claims 25 and 30. *EHC Journal* merely discloses using a Woods lamp to identify the presence of fungal and bacterial infectious agents on skin or in wounds. Hence, the Examiner has not shown that the prior art suggests the desirability of using a Woods lamp to facilitate extracting a representation of a skin condition from a received image. Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness, and is instead using the teachings of the present application in hindsight to reconstruct the prior art.

Accordingly, for at least the above reasons, the rejection of independent claims 25 and 30 under 35 U.S.C. § 103(a) should be withdrawn.

**Conclusion**

Applicants respectfully request reconsideration of this application, withdrawal of the outstanding claim rejections, and the timely allowance of the pending claims.

Applicants respectfully submit that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

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